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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,844	08/10/2000	Nicholas L. Abbott	2307Z-085820US	7090

20350 7590 02/12/2002

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EXAMINER

CELSA, BENNETT M

ART UNIT PAPER NUMBER

1627

DATE MAILED: 02/12/2002 ~~02/12/2002~~ 2-20-02

Please find below and/or attached an Office communication concerning this application or proceeding.

file  
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## Office Action Summary

Application No.  
**09/637,844**

Applicant(s)  
**Abbott et al.**

Examiner  
**Bennett Celsa**

Art Unit  
**1627**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 66-89 and 109-113 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 66-89 and 109-113 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 66-89 and 109-113 are currently pending.

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 66-75 and 109-113, drawn to a device, classified in class 252 and 349, various subclasses .
  - II. Claims 76-89, drawn to a method for detecting an analyte, classified in class 436, subclass 164+.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus or by hand and the apparatus as claimed can be used to practice another and materially different process such as an optical storage medium.
3. Because these inventions are distinct for the reasons given above and
  - a. have acquired a separate status in the art as shown by their different classification;
  - b. require different and separately burdensome manual and/or computer patent and literature bibliographic searches; and/or

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c. have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

***ELECTION OF SPECIES (FOR GROUPS I AND II ABOVE)***

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

A. RECOGNITION MOIETY (GPS I OR II) (e.g. see e.g. claim 81)

B. ANALYTE (GPS I OR II) (e.g. see claims 67, 77 etc.)

C. INTERACTION TYPE (GPS I OR II) (e.g. see claim 68)

D. MEANS OF DETECTION (GP II ONLY) (e.g. markush of claim 86-89)

The above "generic" categories of A-D contain members thereof which are independent and/or distinct from each other since they each encompass compound structures and/or modes of action which are different mechanically, chemically and/or biologically; the compounds are capable of separate manufacture and/or use; differ in reactivity and/or the ability to be incorporated into a device or method. Therefore, the different groups (e.g. A-D and individual members thereof) have different issues regarding patentability and require different and individually burdensome manual and/or computer classification and/or bibliographic searches.

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Applicant is required under 35 U.S.C. 121 to elect a *single disclosed species (e.g. a specific compound or class of compounds for a moiety or analyte and a specific species of interactions or means of detection)* ) from each of the above categories (if applicable) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. For example, if a biomolecule is elected applicant must elect at least a specific category of biomolecule (e.g protein, nucleic acid etc.)

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

February 19, 2002

BENNETT CELSA  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bennett Celsa', is written over the printed name and title.